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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,891	09/18/2000	Robert Chojnacki	N0064US	4137

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NAVIGATION TECHNOLOGIES
222 MERCHANDISE MART
SUITE 900, PATENT DEPT.
CHICAGO, IL 60654

EXAMINER

KHOSHNOODI, NADIA

ART UNIT	PAPER NUMBER
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2133

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/663,891	CHOJNACKI, ROBERT	
	Examiner	Art Unit	
	Nadia Khoshnoodi	2133	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/26/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-39 is/are allowed.
- 6) ☒ Claim(s) 1-6, 8 and 9 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/18/2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Terminal Disclaimer

The terminal disclaimer filed on 10/26/2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of the full statutory term of prior patent No. 6,768,942 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: elements 40, 60, and 62 regarding fig. 1. Furthermore, element 22 has been used to designate a “distribution medium” in fig. 1 (as described on pg. 11 of the specification) and a specifically a “data storage device” in fig. 3 (as written on pg. 14 of the specification). Please review the figures and the specification in order to ensure that they are consistent with one another, as well as to ensure that all of the figure elements are described in the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Allowable Subject Matter

I. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art, Porter et al. United States Patent No. 5,845,067, teach a method for on-line mass distribution of data products to end users, the method comprising: maintaining a first portion of each of said data products at a first location (col. 3, lines 28-34), maintaining a second portion of each of said data products at a second location (col. 3, lines 35-56); for each of said end users, confirming the end user's entitlement to one of said data products (col. 5, lines 30-35); obtaining a first portion of said one of said data products from said first location and a second portion of said one of said data products from said second location; combining said first portion of said one of said data products and said second portion of said one of said data products, and providing said combined first portion and second portion to said user (col. 1, lines 41-46). The prior arts taken singly or in combination fail to anticipate or render obvious this limitation as claimed in combination with the steps of: combining at the second location.

II. Claims 10-39 are allowed.

The following is an examiner's statement of reasons for allowance: The prior art, Porter et al. United States Patent No. 5,845,067, teach a system for securely conveying a data product,

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the data product defining a first portion and a second portion, the system comprising, in combination: a first entity maintaining the first portion (col. 3, lines 28-34); a second entity maintaining the second portion (col. 3, lines 35-56). The prior arts taken singly or in combination fail to anticipate or render obvious this limitation as claimed in combination with the steps for: encrypting the first portion of data and then sending that data to the second entity, wherein the first encrypted portion of data is stored with the second portion. Furthermore, the prior art does not teach the third entity gaining access to the first decryption key in order to access the data product.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claim Rejections - 35 USC § 102

III. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

IV. Claims 1 and 3-4 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Porter et al., United States Patent No. 5,845,067.

As per claim 1:

Porter et al. teach a method for on-line mass distribution of data products to end users, the method comprising: maintaining a first portion of each of said data products at a first location (col. 3, lines 28-34), maintaining a second portion of each of said data products at a second location (col. 3, lines 35-56); for each of said end users, confirming the end user's entitlement to one of said data products (col. 5, lines 30-35); obtaining a first portion of said one of said data products from said first location and a second portion of said one of said data products from said second location; combining said first portion of said one of said data products and said second portion of said one of said data products, and providing said combined first portion and second portion to said user (col. 1, lines 41-46).

As per claim 3:

Porter et al. teach the method of claim 1, wherein said data products include digital copies of movies (col. 7, lines 27-32).

As per claim 4:

Porter et al. teach the method of claim 1, wherein said data products include digital copies of musical songs (col. 7, lines 27-32).

Claim Rejections - 35 USC § 103

V. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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VI. Claims 2 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porter et al., United States Patent No. 5,845,067.

As per claim 2:

Porter et al. substantially teaches the method, as applied to claim 1 above. Not explicitly disclosed by Porter et al. is the method, wherein said data products include geographic databases. However, Porter et al. teaches that a document can be any information stored as files in a file system, which can equate to the information contained by a geographic database. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Porter et al. for the data product to include files of geographical information stored in a file system, which is equivalent to a database. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Porter et al. in col. 7, lines 26-32.

As per claim 8:

Porter et al. substantially teaches a system for secure on-line mass distribution of data products to end users comprising: an entity having associated therewith copies of first portions of a plurality of data products (col. 1, lines 27-33); a plurality of data distribution terminals, each of which has associated therewith copies of second portions of said plurality of data products (col. 1, lines 33-37); a communications system that provides for exchange of data between the entity and said plurality of data distribution terminals (fig. 3), and a data distribution program that provides copies of said data products to those end users who are entitled to have said copies thereof (col. 1, lines 38-46), wherein said data distribution program provides a copy of a data product by combining a copy of the first portion of said data product obtained from said

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authorization server with a copy of the second portion of said data product obtained from one of said plurality of data distribution terminals (col. 1, lines 38-46).

Not explicitly disclosed by Porter et al. is an “authorization server” as the entity.

However, Porter et al. teach that the devices can be clients or servers. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Porter et al. to use an authorization server to hold the first portion of the plurality of data products. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Porter et al. in col. 3, line 66 – col. 4, line 5.

As per claim 9:

Porter et al. substantially teach the system, as applied to claim 8 above. Furthermore, wherein said authorization server also has associated therewith an authorization database containing data indicating entitlement by said end users to copies of said data products (fig. 1, element 120 and 130).

VII. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porter et al., United States Patent No. 5,845,067 as applied to claim 1 above, and further in view of Ahrens et al., United States Patent No. 5,951,620.

As per claim 5:

Porter et al. substantially teach the method, as applied to claim 1 above. Not explicitly disclosed is the method further comprising the step of: encrypting said first portion of each of said data products. However, Ahrens et al. teach that encryption should be used to prevent unauthorized access to the files. Therefore, it would have been obvious to a person in the art at

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the time the invention was made to modify the method disclosed in Porter et al. to encrypt the first portion of each of the data products. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Ahrens et al. in col. 7, lines 59-67.

As per claim 6:

Porter et al. substantially teach the method, as applied to claim 1 above. Not explicitly disclosed by Porter et al. is the method, further comprising the step of prior to the step of combining, encrypting said first portion of one of said data products. However, Ahrens et al. teach that encryption should be used to prevent unauthorized access to the files. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Porter et al. to encrypt the first portion of each of the data products at some time before combining it with the second portion. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Ahrens et al. in col. 7, lines 59-67.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nadia Khoshnoodi whose telephone number is (571) 272-3825. The examiner can normally be reached on M-F: 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nadia Khoshnoodi

Nadia Khoshnoodi
Examiner
Art Unit 2133
3/02/2005

NK

Albert Decady
ALBERT DECADY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100